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PATENT1653  
Docket No. 251002009400

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Rebecca McElroy

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Eiko SEKI et al.

Serial No.: 09/994,573

Filing Date: 26 November 2001

For: METHODS FOR PRODUCING PROTEIN  
DOMAINS AND ANALYZING THREE  
DIMENSIONAL STRUCTURES OF  
PROTEINS BY USING SAID DOMAINS

Examiner: Hope A. Robinson

Group Art Unit: 1653

**SUBSTITUTE AMENDMENT UNDER 37 C.F.R. § 1.111**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to an Office Action herein, mailed 15 April 2004, time for response to which was set to expire 15 May 2004. A petition for an extension of time of one (1) month until 15 June 2004 is attached hereto, along with the required fee. The Office action indicated that the previous response canceled all claims readable on the elected invention and substituted a new invention. Applicants were given one month to correct this asserted deficiency. Applicants

appreciate the helpful telephone discussions with Examiner Robinson concerning this issue. As

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currently understood, the problem arose because the proposed claims were directed to a method to identify a soluble domain while the elected invention was directed to a method for producing a soluble protein. The Examiner kindly suggested that the elected claims, claims 1-7 and 10-14 be amended rather than an attempt made to substitute new claims. After consultation with her supervisor, the Examiner also indicated that the proposed new claims, if resubmitted, would be withdrawn from consideration as directed to a different invention. In view of this discussion, the following substitute amendment is submitted.

In the original Office action, mailed 20 August 2003, the considered claims, claims 1-7 and 10-14, were rejected. Careful consideration has been given to these grounds for rejection. The amendment and discussion that follow take account of these grounds of rejection; the discussion, in many respects, is identical to that submitted in the previous response. However, the discussion has been modified to reflect the current amendments. Reconsideration is respectfully requested.